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EXAMINER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/827,291
Filing Date: April 05, 2001
Appellant(s): WATERS ET AL.

James D. Wood
For Appellant

EXAMINER'S ANSWER

MAILED
APR 21 2006
GROUP 3600

This is in response to the appeal brief filed March 6, 2006 appealing from the Office action mailed on November 16, 2005.

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(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

| | | |
|-----------|------------------|---------|
| 6,662,166 | Pare, Jr. et al. | 12-2003 |
| 6,202,151 | Musgrave et al. | 03-2001 |

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-4, 6-11, and 13-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,662,166 to David Ferrin Pare, JR. et al. in view of U.S. Patent No. 6,202,151 to Clyde Musgrave.

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1. As per claims 1, 3, 6, 8, 13, and 15, Pare clearly teaches a system and method for providing consumer access to a financial account to implement a transaction comprising:

- a biometric data capture device for reading consumer biometric data (See pare figure 1 and 2 and associated text); and
- a database server for generating a data storage key from the consumer biometric data received from the biometric data capture device and for retrieving a financial account data record corresponding to the generated data storage key (See Pare figure 2 and 3 and associated text, column 4, lines 34-37, column 5, lines 15-55, column 6, lines 67-13 and lines 47-54, and column 9, lines 54-58)
- a payment device for sending said compared biometric data to a merchant payment host as the identifier for the consumer's financial account data (See Pare figure 2 and 3 and associated text, column 4, lines 34-37, column 5, lines 15-55, column 6, lines 67-13 and lines 47-54, column 9, lines 54-58, and column 15, lines 24-67).
- an identity database comprised of data records stored with reference to a data storage key corresponding to biometric data contained within the data record so that the database server may retrieve records from the identity database using data storage keys generated from the received biometric data (See Pare figure 2 and 3 and associated text, column 4, lines 34-37, column 5, lines 15-55, column 6, lines 67-13 and lines 47-54, column 9, lines 54-58, column 11, line 46-column 12, line 23, and column 15, lines 24-67).

What is not clear and explicit from the teachings of Pare exactly how a digital signature (certificate) is generated from the biometric information (See Pare column 12, lines 5-23) However, Musgrave is specific and clear on application and use of specific biometric information and creating a hash value of the information and signing the biometric certificate and forwarding the data to the authenticating authority (See Musgrave column 5, line 15-column 6, line 24). Therefore, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to apply the Musgrave method and system within the method and system of Pare for the motivation of further

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enhancement of both security as well as accuracy as well as reduction of computational resources (See Musgrave column 3, lines 8-22)

2. As per claims 2, 4, 7, 9, 10, and 16, Pare clearly teaches all the limitations of claims 1, 3, 6, 8, and 9, further Pare teaches;

a payment device coupled to said biometric data capture device, said payment device generating a digital signature from said biometric data for a transaction message (See Pare column 9, lines 16-31, lines 49-52, and lines 59-64, and column 12, lines 5-23).

3. As per claims 11, 14, and 16, Pare clearly teaches all the limitations of claims 9, 13, and 15 further,

comparing the generated digital signature to a received digital signature to authorize generation of electronic funds in response to said generated digital signature corresponding to said received digital signature (See Pare column 12, lines 5-23).

(10) Response to Argument

4. In response to appellant's arguments regarding the filing date of the application being April 5, 2001 and the Pare '166 being June 11, 2001 and the assertion by appellant that Pare is not qualified as prior art is in err. Examiner would like to point out the appellant's misrepresentation of the examiner's response to the argument appellant put forward in the last office action dated November 16, 2005. It is clearly disclosed on the face of the Pare '166 that it is continuation of application no. 09/239,570, which is now patent no. 6,269,348 that was filed on January 29, 1999. However, appellant first asserted that the content of the two applications are different therefore, the continuity is not valid (See remarks section footnote page 3 of Amendment filed on August 25, 2005.) And know in the current appeal brief the appellant is asserting that Pare '166 is not available as prior art because "When patent is used as a reference, the MPEP states that "[t]he filing date , in *most* instances also given on the face of the patent, is *ordinarily* the effective date as a reference. MPEP § 901.04." [emphasis added]

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5. Examiner would like to further clarify the position of the examiner in this matter that MPEP clearly permits the examiner to rely on the filing date of the parent application for the purposes of benefit of the earlier effective date of the prior art. MPEP 201.11 [R-3]

Claiming the Benefit of an Earlier Filing Date Under 35 U.S.C. 120 and 119(e)

Under certain circumstances a later-filed application for patent is entitled to the benefit of the filing date of a prior-filed nonprovisional application or provisional application which has at least one common inventor. The conditions are specified in 35 U.S.C. 120 and 37 CFR 1.78(a)(1) – (a)(3) for the benefit claim of a prior nonprovisional application and 35 U.S.C. 119(e) and 37 CFR 1.78(a)(4) – (a)(6) for the benefit claim of a prior provisional application.

6. It should be added that the examiner has not relied on the earliest date of the parent application, as it appears to be the current application is a CIP of the original application filed on November 28, 1994. However, the examiner relied on the earlier date of a direct continuation, which was parent application number 08/705,399 filed on August 29, 1996, now Patent No. 5,870,723, Examiner has reviewed both the immediate patents of Pare '166 and intervening patent Pare '348 as well as direct parent Pare '723 extensively and concluded that they are identical in content and all the portions of the Pare '166 that the examiner has relied on rejecting the current claims are included in the disclosures of the two immediate parent applications, which claim priority to August 29, 1996, the date the examiner has relied on for the rejections. However, examiner in the final office action mailed on November 16, 2005, did invite the appellant to present the examiner with any specific evidence or column or line that would identify that the two mentioned prior art might not be of exact content, which the examiner has relied on in his rejection. Therefore, the examiner's rejection under U.S.C. § 103 is proper and establishes the merits of a *prima facie* case of obviousness under U.S.C. § 103 rejection. Hence, the rejections were maintained.

7. Examiner has included copies of the supporting material only as further evidence of the arguments made in this document. These supporting documents are solely provided to demonstrate one of ordinary skilled in the art would have had the knowledge to rely on and the basic understanding of the art for the purposes demonstrating fundamental bases in the art and of the following discussion.

8. The examiner would like to bring The Boards attention to the process of capturing of the barometric information from the user and how this accomplished in addition to utilizing such information

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for further processing account transactions such as account identification as well as approval of an specific financial transaction. It is clear to one skilled in the art that in order to capture ones biometric information it needs a device to process such information to arrive at a numerical value, which is unique to the individual. That is why the biometric information is extremely difficult to be generated in a fraudulent manner. Essentially all biometrics products operate in similar way.

9. First step is to register the biometric captured information as a unique value in a data structure, which is a registration process to associate the captured information with any other types of data. System captures a sample of the biometric characteristic. Unique features are then extracted by the system and converted into a mathematical code (a value, number, serial key, or an identifier). This code (or sample) is then stored as the biometric template for that person. The template (a mathematical code) may reside in a biometric system itself, or in any other form of memory storage, such as a computer database, a smart card, or bar code. At the heart of the biometric system resides a proprietary element, the engine, which extracts and processes the biometric data. This may apply an algorithm to arrive at the calculated data (code) for the storage. Therefore, the use of the biometric information is directly results in generation of a uniquely identifiable code based on a certain algorithm (Defending Your Digital Assets, Chapter 12, Part 3, Page 364-365). As it was stated above this code is stored in a database or a storage device for further use in comparing the registered sample (as registered extracted code) with the obtained sample (new extracted code) to verify the validity of the biometric sample (code). What the appellant has clearly admitted in page 16, line 3 is that "Accordingly, a "key" is a value that uniquely identifies a particular record so as to allow retrieval of the record." What has been clearly stated by the prior art of the record is identification of the biometric data (code) and matching such data with what stored data to identify financial account (See Pare column 5, lines 15-33, column 9, lines 5-9 and lines 53-58). Pare '166 clearly states that the captured biometric information is used as an identifier (code) and is directly linked to "payor's credit/debit account number".

10. in further clarifying the citation of the appellant on page 15 of the Brief, Examiner would like to sight the definition of the database as it has been provided by the IEEE 100, "The Authoritative Dictionary of IEEE Standards Terms", 7th Edition, Published in 2000;

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database (DB) (1)(A) a collection of logically related data stored together in one or more computerized files. Note: Each data item is identified by one or more keys.

11. Additionally examiner would like to expand on the usage of index key in databases. As it is clearly understood by one skilled in the art in a database, every table should have a column or combination of columns that uniquely identifies every row in the table. This column is called the primary key, which is represented by a unique value such as a value derived from a biometric information capture for its uniqueness of the value. Selecting the primary key for a table is sometimes a challenge. For example, what field should be used as the primary key for the financial account holder? Several choices come to mind; Last Name, combination of First and Last Name, or the Phone Number, or any other combination or single use of a data value. As one can see many of these fields may not be unique to the account holder. Therefore, it can create problems on uniquely identifying a data row (data sets such as financial or identification or both) in a database that is associated with user. To uniquely identify the requested information from amongst very large number of data in a database it is essential to have a unique identifying key for each data set in order when the search and matching process is taking place the right data set would be located within the database. Here the prior art Pare '166 clearly shows that a database is used (See Pare column 9, lines 7-9, lines 53-58, for storing all the relevant data for a financial account of a user and how the captured biometric information is used for comparing (See Pare column 10, lines 3-5) such captured biometric information with the stored biometric information to identify the correct financial account information for approval or decline (See Pare column 11, line 46-column 12, line 4).
12. It is clear by the teachings of the Pare '166 reference that a database is used for storing the biometric information and one skilled in the art knows that the biometric information is stored as a binary number representing the captured information and such stored binary number (numerical value, which applicant calls "key") is used to be compared with the newly provided binary number (a value mathematically derived from the biometric captured information) to identify and retrieve the financial data set associated with such numerical value (key). Therefore, the examiner believes the argument put forward by the appellant that the prior art does not teach or fairly suggest the claimed invention is in error.

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13. As per argument of the appellant on the generation and usage of the "key" to locate a financial record to conduct a transaction, the prior art clearly discussed the use of a key (unique value code) as it has been discussed above and the nature and merits of the argument put forward by the examiner. Additionally examiner would like to point out that there is nothing in the claims that precludes the identification of any other data within the database before or after the financial information has been identified, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

14. The current claims 1, 3, 6, 8, 13, and 15 are basically states;

"[r]etrieving a financial account data record corresponding to the generated data storage key."

15. There is no specific prohibition of identification of the account user by the biometric information captured in the above claims for the purposes of identification of the financial account to be used by the system for approval or rejection of the transaction. There are many other information in a normal database that are corresponding to a unique key of the dataset. The Boards attention is directed to the fact that the process of identifying or retrieving a financial account data record from captured biometric data is only an intended use of such information captured by the system.

16. Applicant is in err in referencing the examiner's interpretation of the claims. As it is clearly understood by the appellant it is the broadest interpretation of the claims that should be given to the claim in light of the specification but not interpreting the claims by introducing limitations into the claims. There is no limitation or step in the claims that dictates that the financial account data record does not include identification of the user or such identification step is taken place before the account information is retrieved or after the account information retrieval. Therefore the appellant's argument is in err.

17. Further the appellant has argued that the retrieval of the financial account data is "solely" based on the biometric data. It seems to the examiner that the appellant has not clearly understood the prior arts of record. It should be noted that the Pare '166 clearly states the objective of the invention is to avoid use

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of tokens for conducting financial transaction and such transaction would be authorized or denied "solely from an analysis of a user's unique biometric characteristic" (See Pare '166 column 6, lines 49-54).

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



**KAMBIZ ABDI
PRIMARY EXAMINER**

Kambiz Abdi
Primary Examiner
Art Unit 3621

KA
April 14, 2006

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